

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 57

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN R. GAMMINO

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Appeal No. 97-4150  
Application 08/186,820<sup>1</sup>

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HEARD: March 3, 1998

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Before THOMAS, HAIRSTON, and FLEMING, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed January 25, 1994. According to applicant, the application is a continuation of Application 07/911,115 filed July 9, 1992.

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DECISION ON APPEAL

This appeal involves claims 1 through 5, 7, 9 through 11, 13, 15, 16, 18, 20 and 24 through 58.<sup>2</sup>

The disclosed invention relates to a telecommunications method and apparatus for evaluating a third plurality of dialing signals in a dialing sequence to determine whether the dialing signals are located in the dialing sequence to accomplish international dialing. If the third plurality of dialing signals are located in a position for international dialing, then the telecommunications apparatus prevents the establishment of an international telephone call.

Claims 1 and 4 are illustrative of the claimed invention, and they read as follows:

1. Telecommunications apparatus for selectively preventing establishment of a telephone call to a telephone number having a central office exchange code, said telecommunications apparatus being capable of transmitting a dialing sequence which includes a first plurality of dialing signals, followed by a second

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<sup>2</sup> Although claims 8, 14, 19 and 21 through 23 were officially canceled (paper number 44), claims 6, 12 and 17 were not officially canceled by amendment (paper number 40) because the record indicates that the examiner (paper number 42) denied entry of this amendment. Inasmuch as appellant and the examiner both agree (Brief, page 3, and Answer, page 1) that claims 6, 12 and 17 are not on appeal, we will limit our review to the appealed claims 1 through 5, 7, 9 through 11, 13, 15, 16, 18, 20 and 24 through 58.

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plurality of dialing signals followed by a third plurality of dialing signals, said telecommunications apparatus comprising:

means for receiving said dialing sequence prior to receiving said central office exchange code;

means for evaluating said third plurality of dialing signals and for preventing establishment of said telephone call if said evaluated third plurality of dialing signals are determined to a) be in a location in said dialing sequence to accomplish international dialing and b) be respective predetermined signals which are used for international dialing irrespective of said second plurality of dialing signals.

4. A method for at least partially preventing operation of a telecommunications device which is capable of transmitting a plurality of signal values, said method comprising the steps of:

a) receiving said plurality of signal values;

b) comparing at least two of said plurality of signal values respectively located at predetermined locations used for international dialing with respective predetermined digit sequences which are used for international dialing and comparing a further signal value located at a further predetermined location with a further predetermined signal value, wherein a plurality of further signal values are located between said at least two of said plurality of signal values and said further signal value; and

c) at least partially preventing operation of said telecommunications device irrespective of said plurality of further signal values if said at least two of said plurality of signal values and any one of said respective predetermined digit sequences are found to be identical in step b) and if said further predetermined signal value is found to be identical to said further signal value.

The references relied on by the examiner are:

Jackson	4,012,602	Mar. 15, 1977
Bimonte et al. (Bimonte)	4,577,066	Mar. 18, 1986
Arbabzadah et al. (Arbabzadah)	4,794,642	Dec. 27, 1988

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TCI TEL Controlling, TC-1013SL Programmable Call Controller For Selective Call Control, 1990, pages 1 through 11.  
FCC Regulations<sup>3</sup>

Claim 42 stands rejected under the second paragraph of 35 U.S.C. § 112<sup>4</sup> as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 1 through 3, 15, 16, 18, 20, 24 through 26, 29 through 32, 35 through 37, 39 through 41, 43 through 45, 47, 48, 50, 51, 53, 54 and 56 through 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bimonte in view of FCC Regulations.

Claims 4, 5, 7, 9 through 11, 13, 27, 28, 33, 34, 38, 42, 49, 52 and 55 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bimonte in view of FCC Regulations and Jackson.

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<sup>3</sup> The prior art listing (Answer, page 4) does not list any regulations. In the rejections, we assume that the examiner is alluding to FCC Regulations that prevent "the blockage of interstate calls from public telephones when these calls are placed using certain access codes" (specification, page 5).

<sup>4</sup> The rejection of claims 30 through 34 under the first paragraph of 35 U.S.C. § 112 has been withdrawn by the examiner (Supplemental Answer, page 3).

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Claims 1 through 5, 7, 9 through 11, 13, 15, 16, 18, 20 and 24 through 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over Arbabzadah.

Claims 1 through 5, 7, 9 through 11, 13, 15, 16, 18, 20 and 24 through 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over the TCI publication.

Reference is made to the briefs and the answers for the respective positions of the appellant and the examiner.

#### OPINION

We have carefully considered the entire record before us, and we will reverse all of the rejections.

In the indefiniteness rejection, the examiner states (Answer, page 6) that:

Claim 42 is confusing because it is unclear under what condition(s) would the means prevent the apparatus from transmitting at least a portion of the sequence. It appears that the means will always and unconditionally prevent the apparatus from transmitting at least a portion of any dialing sequence.

Claim 42 depends from claims 2 and 40. Claim 2 has "means for evaluating said third plurality of dialing signals in a location in said dialing sequence used for international dialing by determining if said third plurality of dialing signals are used to accomplish international dialing," and "means for transmitting said dialing sequence to said communications pathway if said

evaluated third plurality of dialing signals are determined to not be predetermined signals which are used to accomplish international dialing irrespective of said second plurality of dialing signals." In claim 40, the "means for evaluating said third plurality of dialing signals" identifies the first plurality of dialing signals and the second plurality of dialing signals in order to identify the third plurality of dialing signals. Claim 42 further comprises "means for preventing said telecommunications apparatus from transmitting at least a portion of said dialing sequence to said communications pathway." None of the "means" in claims 2, 40 or 42 "will always and unconditionally prevent the apparatus from transmitting at least a portion of any dialing sequence" (Answer, page 6). If the dialing sequence in claim 2 is "not" for international dialing, then the telecommunications apparatus will transmit the dialing sequence to the communications pathway. On the other hand, if the dialing sequence is for international dialing, then the "means" in claim 42 will certainly stop the transmission of the dialing sequence to the communications pathway. The indefiniteness rejection is reversed because there is nothing indefinite about claim 42.

Bimonte discloses a telephone interexchange call routing

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system. The examiner indicates (Answer, page 8) that "[t]he reference differs from the claims in that the reference prevents all 10-XXX or 950-1XXX while the claims prevent 10-XXX or 950-1XXX calls if it is determined that the call is an international call." It is the examiner's belief (Answer, page 8) that "[s]ince interstate calls (e.g., long distance calls) cannot be prevented according to the **FCC Regulations**, then the **Bimonte** system can only prevent intrastate (e.g., local) and international 10-XXX or 950-1XXX calls." The examiner concludes (Answer, pages 8 and 9) that "[s]ince international calls are relatively expensive and it is known that fraudulent international calls cost the industry millions of dollars every year, cause fraud-related crimes and allow 'bad guys' to monopolize pay phones, it would have been obvious to one of ordinary skill in the art to use **Bimonte** for preventing international 10-XXX or 950-1XXX calls." Appellant's response (Brief, pages 12 and 13) to the rejection is that:

Nothing in Bimonte performs the act or function of preventing or restricting the dialing of international calls based upon the third dialing signals being determined to be international dialing signals. As concerns the dialing of 10XXX codes referred to in Bimonte, Appellant's claimed invention, as distinguished from Bimonte, does not restrict dialing based on the use of predetermined 10XXX codes. To put the matter in simple terms, Appellant's claimed

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invention, for example, will prevent a call dialed with the following sequence: 1 800 950 1XXX 01. The digits 01 of course mean that the call is an international one. Bimonte will allow this call to go through because it does not prevent a call based on its determination that the call is international. Appellant's claimed invention will also prevent the call dialed with the following sequences: 950-1XXX-01 and 10XXX-01. By contrast, Bimonte will allow 950-1XXX-01 calls if the carrier accepts 950-XXXX calls (see Bimonte, col. 24 line 17). Bimonte will also allow 10XXX-01 calls if the carrier accepts 10XXX calls and the dialing is not originating from a terminal from which any dialing or 10XXX dialing is prohibited. . . .

Appellant summarizes his arguments concerning Bimonte by stating (Brief, page 13) that "[a]lthough Bimonte discloses the determination as to whether a call is an international call, no prevention of the call is disclosed in Bimonte on the basis of that determination, i.e. the call being an international call."

With respect to the FCC Regulations, appellant argues (Brief, page 15) that:

FCC Rules 47 C.F.R. 64.704 and 64.706 state that (certain types of) access to interstate carriers cannot be blocked. By contrast, Appellant's claimed invention relates to the blocking of certain calls when international dialing digits are detected in a certain location in the dialing sequence. Specifically, Appellant evaluates a third plurality of dialing digits in the dialing sequence. Appellant's evaluation of the third plurality of dialing digits is completely unrelated to Title 47 of the FCC Regulations.

Again, the FCC Regulations state that blocking certain calls is prohibited. Compare this to Appellant's claimed invention which legally blocks certain calls without violating the FCC Regulations.

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We agree with appellant that Bimonte and the FCC Regulations neither teach nor would they have suggested the prevention of international calls based upon a determination of specific digits in a dialing sequence. Accordingly, the obviousness rejection of claims 1 through 3, 15, 16, 18, 20, 24 through 26, 29 through 32, 35 through 37, 39 through 41, 43 through 45, 47, 48, 50, 51, 53, 54 and 56 through 58 based upon the combined teachings of Bimonte and the FCC Regulations is reversed.

The obviousness rejection of claims 4, 5, 7, 9 through 11, 13, 27, 28, 33, 34, 38, 42, 49, 52 and 55 based upon the combined teachings of Bimonte, the FCC Regulations and Jackson is reversed because Jackson's teachings of prohibiting all but local calls by disabling the telephone dial circuit "[w]hen the number of digits dialed exceeds the minimum number required to place a local telephone call" (column 1, lines 51 through 61) do not cure the noted shortcomings in the combined teachings of Bimonte and the FCC Regulations (Brief, page 18).

Arbabzadah discloses control equipment in a customer-owned public telephone station that prevents a user from making unauthorized telephone calls on a telephone line (column 1, lines 50 through 53). The equipment is controlled by CPU 106 (Figure 1), and a table of calls to be blocked are stored in EEPROM 113

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(column 3, lines 1 through 12). According to the examiner  
(Answer, page 11):

**Arbabzadah et al** teaches the general scheme of blocking certain types of calls but does not specifically teach blocking international calls. However, a) it is well known in the art (and acknowledged by Appellant) that fraudulent international calls cost the industry millions of dollars every year, cause fraud-related crimes and allow "bad guys" to monopolize pay phones and b) it is well known that international calls can be made by using access codes such as 10-XXX-01.... or 950-1XXX1.... (or the like). The above points (a & b) represent notoriously well-known FACTS.

Thus, if the owner of the **Arbabzadah et al** public telephone desires to prevent the users from making international calls, this can obviously be achieved by simply programming the sequence 10-XXX-01 (or the like) in the table as a prohibited sequence. Programming a sequence such as 10-XXX-01 or the like is within the teachings of **Arbabzadah et al**.

We agree with the examiner that the skilled artisan armed with the teachings of **Arbabzadah** would have known to place international telephone numbers in the EEPROM table 113. On the other hand, we agree with the appellant that the skilled artisan would have had to look to appellant's disclosure and claimed invention for a teaching of specifically "'looking for' a third plurality of dialing digits and preventing a telephone call if the third plurality of dialing digits are international dialing digits" (Brief, pages 19 through 22). The examiner cannot rely

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on prohibited hindsight to establish the obviousness of the claimed invention. For this reason, the obviousness rejection of claims 1 through 5, 7, 9 through 11, 13, 15, 16, 18, 20 and 24 through 58 based upon the teachings of Arbabzadah is reversed.

A stored table of prohibited calls in the TCI publication includes direct dialed international calls (pages 7 and 8). The examiner states (Answer, page 13) that "if the owner of the **TCI** device desires to prevent users from making international calls by using access codes, this can obviously be achieved by simply programming the sequence 10-XXX-01 (or any other similar sequence) in the deny table." Appellant's response (Brief, page 23) is that:

As with the Arbabzadah reference, the TCI reference does not provide a suggestion to be programmed as . . . argued. More specifically, the TCI reference does not specify any motivation to program the TCI device as recited by Appellant's claims to evaluate the third plurality of dialing digits and to block the call if these digits are international dialing digits. Appellant's statements regarding the Arbabzadah reference apply equally to the rejection based upon the TCI reference. The fact that TCI "could be" programmed to read on Appellant's claims is irrelevant without a teaching or motivation from the art to make the desired modification.

We agree with appellant that "[h]indsight, alone, is an improper basis to reject Appellant's claims" (Brief, page 24). The obviousness rejection of claims 1 through 5, 7, 9 through 11, 13,

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15, 16, 18, 20 and 24 through 58 based upon the teachings of the TCI publication is reversed.

In the absence of a prima facie case of obviousness, we see no need to comment on appellant's evidence of secondary considerations.

DECISION

The decision of the examiner is reversed because of the reversal of all outstanding rejections.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
KENNETH W. HAIRSTON	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	

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RATNER AND PRESTIA  
500 North Gulph Road  
P.O. Box 980  
Valley Forge, PA 19482